

REMARKS

I. Introduction

Claims 1 to 9, 11 to 16, 19 to 21, and 37 to 51 are currently pending. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 2, 7 to 9, 11, 12, 14 to 16, 19, 40 to 43, and 48 to 51 Under 35 U.S.C. § 103(a)

Claims 1, 2, 7 to 9, 11, 12, 14 to 16, and 19, 40 to 43, and 48 to 51 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,576,167 ("Noiles") and U.S. Patent No. 5,402,769 ("Tsuji"). It is respectfully submitted that the combination of Noiles and Tsuji does not render unpatentable the present claims for at least the following reasons.

Each of independent claims 1, 11, and 40 recites a coupling connected to a distal end of an outer sheath and a moisture sensor disposed within the coupling.

As regards Noiles, the Final Office Action contends that the threaded distal end portion 234, shoulder 235, rod 30, hollow extension tube 78, L-shaped slots 264, and retention ring 260 together comprise a coupling. Final Office Action, pages 2 to 3. The Final Office Action then asserts that "[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a moisture sensor such as that disclosed by Noiles. A skilled artisan would be motivated to do so in order to enhance reusability by enabling sterilization, a necessary precondition of reusability in surgical instruments." Final Office Action, page 4. Applicant respectfully disagrees.

Referring, for example, to Figures 3 and 5 of Noiles, it is readily apparent that there is no interior volume that is sealed from the external environment. For example, the space between extension tube 78 and the rod 30 is in communication with the external environment, as there is substantial clearance between the tube 78 and the rod 30 along the axial length. Moreover, the space between the outer tube shaft 60 and the extension tube 78 is in communication with space between the extension tube 78 and the rod 30 via the longitudinal slots 79. As such, the space between the outer tube shaft 60 and the extension tube 78 is also in

communication with the external environment. It is therefore clear that no portion within what the Final Office Action considers to be a coupling has any sealed interior portion. Accordingly, there is no apparent motivation or reason why one of ordinary skill in the art would include a moisture sensor within the portion considered by the Examiner to constitute a coupling. Moreover, there is no indication whatsoever that the presence of moisture within the outer shaft tube 60 would make the device of Noiles, which does not include any internal electronics, any less sterilizable. Indeed, the combination of Noiles and Tsuji, does not disclose, or even suggest, a coupling connected to a distal end of an outer sheath and a moisture sensor disposed within the coupling, as recited in the present claims.

As best understood by Applicants, the Final Office Action appears to rely on a teaching, suggestion, or motivation to combine references to modify or combine the references to arrive at the claimed features. See, e.g., Final Office Action, page 3, para 07c (“A skilled artisan would be motivated”). However, M.P.E.P. § 2143 recites that

Office personnel **must** articulate the following:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

(Emphasis added). As set forth above, there is no apparent motivation for one of ordinary skill in the art to combine the references in the manner suggested by the Final Office Action. Further, the present rejection is deficient for at least the additional reason that it does not articulate a finding of a reasonable expectation of success.

In view of all of the foregoing, it is respectfully submitted that the Final Office Action has not properly established a prima facie case of obviousness as

required under KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) or in compliance with M.P.E.P. § 2141 et seq. with regard to any of claims 1, 11, and 40, or any of dependent claims 2, 7 to 9, 12, 14 to 16, and 19, 41 to 43, and 48 to 51. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 37 to 39 Under 35 U.S.C. § 103(a)

Claims 37 to 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Noiles and Tsuji. It is respectfully submitted that the combination of Noiles and Tsuji does not render unpatentable these claims for at least the following reasons.

Claim 37 recites a coupling detachably connected to an end of the outer sheath and a moisture sensor disposed within the coupling configured to detect moisture within the outer sheath. Claim 38 recites a coupling connected to a distal end of the outer sheath wherein the coupling includes a moisture sensor.

As indicated above, the combination of Noiles and Tsuji, does not disclose, or even suggest, a coupling connected to a distal end of an outer sheath and a moisture sensor disposed within the coupling. For at least the same reasons set forth above with respect to the rejection of claims 1, 2, 7 to 9, 11, 12, 14 to 16, and 19, 40 to 43, and 48 to 51, it is respectfully submitted that the combination of Noiles and Tsuji does not render unpatentable the present claims. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 3, 13, and 44 Under 35 U.S.C. § 103(a)

Claims 3, 13, and 44 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Noiles, Tsuji, and U.S. Patent No. 6,099,464 (“Shimizu”). As discussed above, the combination of Noiles and Tsuji does not disclose, or even suggest, all of the features included in claims 1, 11, and 40. Shimizu fails to cure this deficiency, as Shimizu fails to disclose, or even suggest, a moisture sensor within a coupling connected to a distal end of an outer sheath. As such, it is respectfully submitted that the combination of Noiles, Tsuji, and Shimizu does not render unpatentable any claim that depends from claim 1, 11, or 40.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 4 to 6, 20, 21, and 45 to 47 Under 35 U.S.C. § 103(a)

Claims 4 to 6, 20, 21 and 45 to 47 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Noiles, Tsuji and U.S. Patent No. 4,654,701 ("Yabe"). As further set forth above, Noiles and Tsuji, alone or together, do not disclose all of the features of independent claims 1, 11 and 40. Yabe fails to cure this deficiency as Yabe fails to disclose, or even suggest, a moisture sensor within a coupling connected to a distal end of an outer sheath. As such, it is respectfully submitted that the combination of Noiles, Tsuji, and Yabe does not render unpatentable dependent claims 4 to 6, 20, 21 and 45 to 47.

In view of the foregoing withdrawal of this rejection is respectfully requested.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Any fees for extension(s) of time or additional fees required in connection with the filing of this response, are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is authorized to charge any such required fees or to credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,

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